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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,195	12/31/2003	Kenichi K. Yabusaki	03-YAB-116	2552
23843	7590	11/16/2006	EXAMINER	
FOOTHILL LAW GROUP 777 N. FIRST STREET, SUITE325 SAN JOSE, CA 95112			SMALLEY, JAMES N	
			ART UNIT	PAPER NUMBER
			3781	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/751,195

Applicant(s)

YABUSAKI, KENICHI K.

Examiner

James N. Smalley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-7, 9, 13-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wortham US 4,750,636 in view of Withers et al. US 5,259,501.

Wortham '636 discloses a soft transparent flexible plastic bag (15), with an opening (17), applied to a transparent container (11). The plastic bag also comprises a tube. Examiner notes the applicant's tube is sealed on the end, and thus has an identical resultant shape as that of Wortham '636, to the best degree the Examiner understands the Applicant's disclosure and side-view figure. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). Thus, in the instant case, Examiner asserts the resultant final products are identical and Wortham '636 properly teaches the claimed structure of a plastic tube.

The container is used to dispose of medical syringes. However, Wortham '636 fails to teach a slit.

Withers '501 teaches it is known to provide an opening of intersecting slits (47) in order to dispose of used medical syringes, and which furthermore prevents unwanted removal of the syringes from the container.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the port of Wortham '636, providing the intersecting slits of Withers '501, motivated by the benefit of preventing inadvertent removal of the disposed contents.

Examiner notes the resultant structure is capable of being used in the intended manner, i.e. as a container for storing split shot. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

3. Claims 8 and 10-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Wortham US 4,750,636 in view of Withers et al. US 5,259,501 as applied above to claims 2 and 9, and further in view of Lovelace et al. US 6,036,038.

Wortham '636 does not teach container neck threading.

Lovelace '038 teaches it is known to provide a glass container neck with threads.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide threads on the neck opening of the container of Wortham '636, as taught by Lovelace '038, motivated by the benefit of securing a cap by a threaded connection on the container.

Regarding claim 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the size and thickness of the bag as desired. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It has been held that discovering an optimum value of a result-effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 12, Wortham '636 does not teach the size of the bag.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the size of the bag taught by Wortham '636, forming it to fit bottles ranging from 0.5 dram and 2 dram bottle, or to any other suitable size, motivated by the benefit of providing a snug fit around the container opening. Furthermore, Examiner notes a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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Further regarding claim 12, Wortham '636 does not teach the container being formed of glass.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the container of Wortham '636 of glass, as taught by Lovelace '038, because it is well known to form containers of glass, or any other suitable material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

4. Claims 5 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Wortham US 4,750,636 in view of Withers et al. US 5,259,501 as applied above to claims 1 and 13, and further in view of Bordage US 6,199,719.

Wortham '636 does not teach a means to hang the container.

Bordage '719 teaches a means for hanging a tube, comprising a hole (27) in a bag, and a loop (35) secured therethrough.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the bag of Wortham '636, providing a hole and a loop, as taught by Bordage '719, motivated by the benefit of providing a means to hang the bag.

#### ***Response to Arguments***

5. Applicant's arguments filed 28 August 2006 have been fully considered but they are not persuasive.

##### ***a) Applicant argues Wortham '636 does not teach a plastic tube.***

Examiner notes it appears the resultant structure of Wortham '636 and that of the instant invention are the same, that being tubes which are sealed on one end. In other words, the bag of Wortham '636 comprises a plastic tube. Should the Applicant rely upon a manufacturing limitation, that being the forming of the instant closure by transverse sealing of a plastic tube, Examiner notes the prior art must only teach the same final product as that of the instant invention. In this case, a plastic bag comprises a plastic tube sealed at one end. It has been held that method limitations in a product claim do

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not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

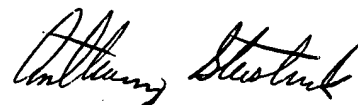
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jns



**ANTHONY D. STASHICK**  
**PRIMARY EXAMINER**